



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper No. 29

In re Application of :
Randall A. Addington *et al* : DECISION ON PETITION
Application No. 09/396,530 :
Filed: September 15, 1999 :
Attorney Docket No. 99-1002 :

This is a decision on the petition filed by facsimile transmission on July 8, 2002 by which petitioners request supervisory review of the examiner's objection to the drawings under 37 CFR 1.83. No fee is required for the petition, and a refund of the \$130.00 petition fee will be scheduled.

The petition is denied.

The examiner has promulgated a requirement that petitioners illustrate certain features of the claimed invention, and certain other features. The examiner has adhered to this requirement after reconsideration thereof. Petitioners have presented arguments that the examiner's requirement conflicts with MPEP § 601.01(f), constitutes disparate treatment of petitioners, is frivolous, and without foundation on the merits.

Petitioners' arguments and analysis are wholly unpersuasive. Petitioners' citation of MPEP § 601.01(f) is inapt. That section deals with applications filed without drawings, and merely sets up an initial test by which the Office of Initial Patent Examination (a technical support branch which processes newly filed applications) may determine whether to initially grant a filing date to an application that is filed without drawings. Reading further in MPEP § 601.01 reveals that an examiner may "reverse" this initial determination whenever drawings are required because such drawings are deemed necessary for the understanding of the subject matter sought to be patented under 35 USC 113, first sentence. This application was not filed without drawings, and no requirement under 35 USC 113, first sentence has been promulgated.

Rather, the objection in this application has been made pursuant to 37 CFR 1.83(a) and 37 CFR 1.81(c), and it is those regulations, which require that all claimed features of the invention be illustrated, and that other features that admit of illustration must be illustrated in accord with 35 USC 113, second sentence (subject matter admits of illustration), which applies even where 35 USC 113, first sentence (drawings **necessary** for understanding the invention) does not apply. The principles underlying these regulations are discussed at MPEP § 608.02(d) with reference to the decision in *Ex Parte Good*, 1911 C.D. 43, 164 O.G. 739 (Comm'r Pat. 1911). That decision indicates that any detail of the invention that is of sufficient importance to be described should be shown in the drawing. Indeed, the *Good* case states that:

"The question is not whether one skilled in the art can decipher the invention, but whether the drawing is so clearly and artistically executed as to facilitate a ready understanding of the invention both at the time of examination and in searches afterward in which reference to the patent must be made." (Emphasis supplied.)

37 CFR 1.83(a) requires that every feature claimed must be illustrated, and is completely in accord with the decision in *Good*.

To the same effect is *Ex Parte Sturtevant et al*, 1904 C.D. 26, 108 O.G. 563 (Comm'r Pat. 1904) in which it is stated:

"It is a great desideratum of Patent Office drawings that they should tell their story to the eye without making it necessary to go into the specification for explanation, which should be apparent upon inspection. ...


The suggestion by the applicants that the Examiner's objection should not be insisted upon, simply because one skilled in the art could make the invention from the present disclosure, does not overcome this necessity for such representation of the invention in the drawings as **will make it intelligible for the purposes of search.**" (Emphasis supplied.)

The examiner has insisted that the drawings be amended to illustrate certain claimed method steps. This is perfectly proper pursuant to 37 CFR 1.83(a). Other features have also been required to be illustrated. This is perfectly proper under 37 CFR 1.81(c). Petitioners have not demonstrated that the examiner has abused his discretion, or acted in an arbitrary or capricious manner, in so requiring. Petitioners have not proffered any evidence at all that this requirement was applied to them unequally. Petitioners have also not demonstrated any impropriety in withholding an allowance of this application until the examiner's objections have been satisfied, so long as the objections are in accordance with the regulations. Therefore, it does not appear that petitioners are entitled to relief.

Petitioners may file a request for reconsideration of this decision, provided that the request is filed within two months of the date of this decision. Petitioner should note that the time for filing a proper reply to the outstanding Office letter dated March 12, 2002, paper No. 33, continues to run as set therein and is not stayed by the filing of the instant petition. See 37 CFR 1.181(f) with respect to the time for filing a request for reconsideration and filing a proper reply. See 37 CFR 1.113 and 1.116 as to a reply which constitutes a proper reply to a final rejection.

The application is being forwarded to the Supervisory Patent Examiner in Art Unit 3711 for immediate action on the paper filed by facsimile transmission on July 12, 2002. Thereafter the application will be forwarded to the Head Supervisory Applications Examiner to refund the \$130.00 petition fee which accompanied the instant petition.

PETITION DENIED.


E. Rollins-Cross, Director, Patent
Examining Groups 3710 and 3720

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